

Application No. 10/628,142
Reply Brief



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: HAASE, Ignatius Xavier

Serial Number: 10/628,142

Examiner: BLACKWELL, James H.

Filed: July 25, 2003

Art Unit: 2176

Confirmation No.: 9437

For: APPARATUS AND METHOD FOR ENCODING AND
DISPLAYING DOCUMENTS

Mail Stop APPEALS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir or Madam:

STATUS OF CLAIMS

Claims 1, 3, 5, 7-8, 13 and 17-20 are pending and rejected, and the appeal is on the rejection of these claims. Claims 2, 4, 6, 9-12 and 14-16 were previously cancelled.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Rejections As Set Forth In the Last Official Action

Claims 1, 3, 5, 7-8, 13 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al (U.S. Patent No. 5,623,679).

More Specific Description of Rejections and Issues

1. In the Office Action of September 9, 2008 (pp. 2 et seq) Claims 1, 3, 5, 7-8, 13 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. Is this rejection proper?

2. In the Office Action (pp. 9-10, section entitled response to argument), there is a discussion of how in Rivette, one **could** create a potentially contiguous line of green triangles, or some other shape, “that depending on perhaps the shape of the symbol ..., symbol size ..., etc. would form a continuous segment of color-coding.” Is this an impermissible obvious to try and/or speculative rejection that cannot be supported by the reference, and in any event is not appropriate for a rejection?

3. In the Office Action (p. 5), there is a discussion of how in Rivette, not only **could** one form contiguous segments (see issue 2 above) but also one **could** have two or more symbols per line: “multiple characteristics **can** be indicated for a line....” (see 4th and 3rd to last lines of page, emphasis added) Is this an impermissible obvious to try and/or speculative rejection that cannot be supported by the reference, and in any event is not appropriate for a rejection?

ARGUMENT

1. The Examiner is using an “obvious-to-try” argument, which is not proper;
2. Rivette does not teach or imply contiguous color coding in the margin; and
3. The purpose of color coding in the margins and contiguously on different but adjacent lines is to show the relationships between the subject of multiple lines of text, and that purpose or any purpose of achieving such contiguous color coding in the margins is completely lacking in Rivette and cannot reasonably or logically be inferred from Rivette.

CLAIM 1:

Claim 1 includes steps of placing and/or creating:

- (i) color-coded segments (as the unique indicia);
- (ii) in the margin adjacent and in line with lines of text; and
- (iii) there are adjacent lines of text having the same color-coded segment in a **columnar, contiguous relationship and perpendicular to the lines of text.**

This arrangement is simply not shown or suggested by Rivette.

Rivette neither teaches nor suggests any such multiple shapes or contiguous arrangement.

Rivette is merely a system and method for creating and manipulating notes and sub-notes for annotating a document and linking the notes and sub-notes to portions of the text of the document. Moreover, even assuming for purposes of argument that one would place multiple “color indicators 542” adjacent one line of text, there is absolutely

no reason, suggestion, or common sense indication that one would make the color indicators run contiguously or continuously down a column in the margin. In fact, that would defeat the purpose of having a shape for each color indicator, does not appear possible given the drawing of Fig. 37 of Rivette, **would be confusing and not sensible from Rivette, and is speculative and hindsight based.**

In view of the above and a review of the action, the action uses an impermissible “obvious-to-try” approach, and impermissible hindsight.

CLAIM 7:

Claim 7 is also believed patentably distinct from Rivette for the same reasons as set forth above with respect to claim 1. There is no basis in Rivette to create contiguous or continuous color segments among multiple adjacent lines of text in Rivette. As noted above, it is not shown in Rivette, does not appear to be possible from Rivette, and would be confusing and illogical.

CLAIM 13:

As in claims 1 and 7, there are at least some color-coded segments placed contiguously with the same color-coded segments from adjacent lines of text and in a columnar arrangement perpendicular to the lines of text, so as to form continuous segments of color-coding, and at least some lines of text have at least two characteristics and a corresponding number of unique indicia in the margin adjacent the lines.

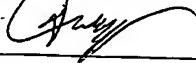
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Accordingly, claim 13 is believed patentably distinct from Rivette for the same reasons as set forth above with respect to claim 1.

Respectfully submitted,

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Date: October 12, 2009



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